

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1, 4-13, and 60-78 are pending in the application, with 1 and 60 being the independent claims.

Double Patenting Rejection

The Examiner rejected claims 1, 4-8, 10-12, 60-65, and 67-69 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-6, and 10-13 of U.S. Patent No. 6,248,127.

Solely in the interest of advancing prosecution, Applicants have filed a terminal disclaimer over U.S. Patent No. 6,248,127 ("the '127 patent"). Thus, reconsideration and withdrawal of the double patenting rejection is respectfully requested.

With respect to the terminal disclaimer that was filed, Applicants note that "the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection. It is improper to convert this simple expedient of 'obviation' into an admission or acquiescence or estoppel on the merits." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 874, 20 U.S.P.Q.2d 1392, 1394-1395 (Fed. Cir. 1991). Thus, Applicants maintain that the currently pending claims of Application No. 09/862,710, directed to a coating composition that may be coated onto a medical device, is a separate invention than the invention directed to a coated medical device, as claimed in U.S. Patent No. 6,248,127.

U.S. Patent No. 6,248,127

Applicants wish to bring to the Examiner's attention that a reissue application has been filed regarding U.S. Patent No. 6,248,127. The assignee of U.S. Patent No. 6,248,127 filed the reissue application in light of the teachings of Nagata *et al.* (U.S. Patent No. 4,082,727). The Examiner of the present application has already cited and considered the patentability of the pending claims in view of the disclosure of Nagata *et al.* (Office Actions mailed October 16, 2003 and April 1, 2003.)

The reissue application has been assigned to Examiner D. S. Nakarani. As of the date this Reply was filed, no Office Action has been issued in the reissue application.

Allowable Subject Matter

The Examiner stated claims 9, 13, 66, and 70-78 are objected to as being dependent upon a rejected base claim. Applicants assert that the Examiner's objection to these dependent claims has been overcome in light of filing a terminal disclaimer over U.S. Patent No. 6,248,127. Thus, reconsideration and withdrawal of the objection is requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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